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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/739,201	12/19/2003	Tobianne Kae Hall	081069-0305599	9856

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EXAMINER

GREEN, BRIAN

ART UNIT	PAPER NUMBER
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3611

DATE MAILED: 01/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/739,201

Applicant(s)

HALL ET AL.

Examiner

Brian K. Green

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 10-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 19-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 May 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9 and 19-22, drawn to pre-fabricated multi-leaf page, classified in class 40, subclass 768.
- II. Claims 10-18, drawn to a method of using a multi-leaf page, classified in class 29, subclass 428.

The inventions are distinct, each from the other because of the following reasons:

Inventions I. and II. are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using the product such as pivoting the top and intermediate leaves away from the base leaf, attaching a blue ribbon to the base leaf in alignment with a window formed in the top and intermediate leaves, pivoting the top and intermediate leaves back onto the base leaf, and hanging the leaves on a wall for display of the ribbon. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Bryan Collins on Jan. 14, 2005 a provisional election was made without traverse to prosecute the invention of Group I., claims 1-9 and 19-22. Affirmation of this election must be made by applicant in replying to this Office action. Claims

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10-18 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Specification

The abstract of the disclosure is objected to because on the last line “leafs” should apparently be “leaves”. Correction is required. See MPEP § 608.01(b).

The disclosure is objected to because of the following informalities: paragraph [0024], line 2, “top leaf 12” should be “top leaf 14”. Paragraph [0024], line 3, “top leaf 12” should be “top leaf 14”.

Appropriate correction is required.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the adhesive and the release liners defined in claims 9,19,20, and 21 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet,

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even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claims 1-9 and 19-22 are objected to because of the following informalities: In claim 1, line 16, and claim 19, line 11, “the overlying relation” should apparently be “an overlying relation” since there is no antecedent basis for “the overlying relation”. In claim 1, line 18, “leafs” should apparently be “leaves”. In claim 9, line 2, “a one or more” should apparently be “on one or more”. In claim 19, lines 15-16, “the aforesaid bonding” should apparently be “the bonding” since there is no antecedent basis for “the aforesaid bonding”. Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 9, lines 4-6 are indefinite since it is not clear how the leaves can be joined together at the edges as defined in claim 1 and also have the one or more release lines defined in claim 9 which depends on claim 1.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Shore (U.S. Patent No. 4,110,923).

Shore shows in figure 3 a base leaf (8”), a top leaf (7”), and an intermediate leaf (9). The base leaf, the intermediate leaf, and the top leaf being arranged in overlying parallel relation and being joined together at edges (by fabric 17”) thereof such that the leaves can be pivotally separated from one another to enable the substrate articles to be mounted therebetween. The top leaf and the intermediate leaf including a pair of aligned windows (13”, 14) for enabling a substrate article to be mounted to the base leaf and exposed through the aligned windows. The top leaf having an additional window (see column 5, lines 18-19, Shore discloses the idea of providing a plurality of windows 13”) formed therein in spaced relation from the aligned windows for enabling an additional substrate article to be mounted beneath the top leaf and exposed through the additional window. The base leaf, the intermediate leaf, and the top leaf of Shore are essentially the same size and external peripheral shape. The base leaf, the intermediate leaf, and the top leaf of Shore having imperforate regions (the areas of the top and intermediate

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leaves which do not have windows therein) overlying one another where no windows are formed in any of the leaves, the overlying imperforate regions enabling a user to perform the functions defined by the applicant in claim 1, steps a and b. In regard to claim 2, Shore shows in figure 3 that the base leaf (8") is imperforate. In regard to claim 3, Shore discloses the idea of making the window (14) in the intermediate leaf smaller than the window (13") in the top leaf, see column 2, lines 18-25. In regard to claim 4, since each of the windows (13") is larger than the window or windows in the intermediate leaf, the additional window would overlies an imperforate portion of the intermediate leaf, i.e. the difference in size between the window in the top leaf and the window in the intermediate leaf would form a frame like portion which would be imperforate and lie directly beneath the window in the top leaf.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shore (U.S. Patent No. 4,110,923).

In regard to claim 5, Shore does not specifically define that the intermediate leaf includes an additional window. Shore discloses the idea of placing a plurality of windows in the top leaf, see column 5, lines 18-19. Shore also shows in figure 3 the idea of placing a window (14) in the intermediate leaf in line with the window in the top leaf in order to allow a portion of the

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intermediate leaf to be seen through the window in the top leaf. It would have been obvious to one in the art to modify Shore by placing an additional window in the intermediate leaf in alignment with the additional window in the top leaf since this would allow a portion of the intermediate leaf to be seen through the additional window in the top leaf which would create a more aesthetically pleasing display. In regard to claim 6, Shore discloses the idea of placing a plurality of windows in the top leaf, see column 5, lines 18-19. It is considered within one skilled in the art to place as many windows in the top leaf as desired. In regard to claim 7, Shore does not disclose making the leaves square in shape. It would have been an obvious matter of design choice to make the leaves square since the applicant fails to define any advantage to making the leaves square and the rectangular leaves taught by Shore would work equally as well.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shore (U.S. Patent No. 4,110,923) in view of Henry et al. (U.S. Patent No. 6,119,386).

Shore discloses the applicant's basic inventive concept except for making the leaves from paper. Henry et al. shows in figures 1-5 sheets that are used to form articles that are made from paper, see column 3, lines 65-67. In view of the teachings of Henry et al. it would have been obvious to one in the art to modify Shore by making the leaves from paper since this would allow the leaves to be made in an easier and less expensive manner.

Claims 9 and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shore (U.S. Patent No. 4,110,923) in view of Baryla (U.S. Patent No. 4,741,119) and Lambert (U.S. Patent No. 5,533,288).

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Shore discloses the applicant's basic inventive concept except for using an adhesive to bond at least two of the leaves together and covering the adhesive with one or more release liners. Baryla shows in figures 8 and 8a the idea of pivotally securing a framing layer (13) to a support (12) with an adhesive (18). In view of the teachings of Baryla it would have been obvious to one in the art to modify Shore by adding an adhesive between at least two of the leaves upper edges since this would allow the leaves to be attached together in a more secure manner and would allow the leaves to be springingly urged toward one another as taught by Baryla, column 2, lines 41-56. Lambert shows in figure 1 the idea of covering adhesive with release liners (29). In view of the teachings of Lambert it would have been obvious to one in the art to modify Shore in view of Baryla by placing one or more release liners over the adhesive since this would help to protect the adhesive from dust and dirt and from being prematurely stuck to an object. In regard to claims 20 and 21, it is considered obvious to one in the art, in view of the teachings of Baryla, to place the adhesive on both sides of the intermediate leaf of Shore since this would allow all three leaves to be attached together in a more secure manner and allow the springing bias to be created between each of the leaves. The releasable liners taught by Lambert would be used to cover all of the adhesive sections in order to protect all of the adhesive from dust and dirt and from being prematurely stuck to an object.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Shadwell teaches the use of a pivotally connected cover to a base.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K. Green whose telephone number is (703) 308-1011. The examiner can normally be reached on M-F 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (703) 308-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


BRIAN K. GREEN
PRIMARY EXAMINER

Bkg
Jan. 24, 2005